

2632

Serial No.: 09/396,352

5/8/2003

DOCKET NO.: NOVA-002-C

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2700

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Tümay TÜMER

Serial No.: 09/396,352

Art Unit: 2736

Filed: September 14, 1999

Examiner: HUANG, S

For: TAG HAVING A SEMICONDUCTOR CHIP AND METHOD OF ATTACHMENT TO  
ARTICLETRANSMITTAL

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MAY 12 2003

Technology Center 2600

Assistant Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231  
Box: AF

Sir: TRANSMITTED HERewith IS

☐ A RESPONSE, ☐ AN AMENDMENT, ☒ AN AMENDMENT AFTER FINAL,

IN THE ABOVE-IDENTIFIED APPLICATION.


☒ Small entity status of this application under 37 CFR §1.9(f) is established  
by a verified statement under 37 CFR §1.27☒ previously submitted.  
☐ submitted herewith.☒ No additional fee is required, as shown below.

CLAIMS PENDING AFTER AMENDMENT		CLAIMS PREVIOUSLY PAID		NEW CLAIMS EXTRA		ADDITIONAL FEES			
						SMALL ENTITY		OTHER THAN SMALL ENTITY	
TOTAL	48	MINUS	48	=	0	x\$9=	0.00	x\$18=	0.00
INDEP	2	MINUS	3	=	0	x\$42=	0.00	x\$84=	0.00
NEW MULTIPLE DEPENDENT CLAIMS					0	x\$140=	0.00	x\$280=	0.00
AND CLAIMS DEPENDENT THEREON					0	x\$140=	0.00	x\$280=	0.00
TOTAL ADDITIONAL FEE						0.00		0.00	

☒ X

This amount is believed to be correct, however, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 19-2816. This authorization applies to both filing fees under 37 CFR §1.16 and processing fees (such as extension of time) under 37 CFR §1.17. A duplicate copy of this transmittal is attached.

Respectfully Submitted,

  
Ronald R. Snider  
Registration No. 24,962

Date: May 8, 2003

Snider & Associates  
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RRS/bam

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RESPONSE TO FINAL OFFICE ACTION

Assistant Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Box: AF

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This paper is responsive to the Final Office Action dated February 11, 2003. All claims stand finally rejected on the references cited. The Examiner, however, has refused to consider Applicant's proof of conception coupled with diligence to constructive reduction to practice as proof of a first invention (Response to Arguments, page 12).

Initially, Applicant would like to note that the Examiner would require Applicant to prove actual construction by the filing date of September 14, 1999. Applicant respectfully submits that the 9/14/1999 application stands as a clear constructive reduction to practice of the invention. Applicant is not required under the patent law to have an actual reduction to practice of the invention in order to file a patent application. Applicant simply was not required to execute a dipole antenna in order to disclose it in the patent application as filed.

The Examiner states as follows:

"In other words, no actual testing or further study were made upon filing of the present invention on 9/14/1999 regarding the use of the dipole antenna on the tag, not to mention that applicant admitted that problems/difficulties and benefits of the use of different types of antennas on tags."

This simply does not overcome the fact that Applicant clearly disclosed the use of a dipole antenna in the 9/14/1999 application. This disclosure stands as a constructive reduction to practice. Actual reduction to practice upon Applicant's filing date or afterward is not a requirement of patent law, see 35 USC § 102(q)

With respect to funding, Applicant respectfully requests the Examiner to consider the following case law which clearly shows that diligence may exist when funding is not present when Applicant is not able to pursue the actual reduction to practice because of financial considerations.

§10.07[4] from Chisum on Patents outlines the law for excuses for inactivity during a period of required diligence. Specifically, the Examiner is referred to part [b] at page 10-261 and footnote 7. The footnote indicates that delay until government financing is obtained may be a reasonable excuse for a period of inactivity.

Attached hereto is a copy of Narda Microwave Corp. v. General Microwave Corp., 207 USPQ 1042 (E.D.N.Y. 1980) which is cited in Chisum. In Narda it was held that even though nothing was done for about a year while the Air Force was considering General Microwave's proposal, that there was diligence. The Court specifically held at page 1059 that General Microwave continued to

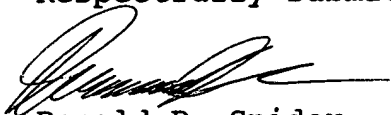
be diligent in pursuit of the invention and succeeded in reducing it to practice by filing the '573 patent application. This is the same situation as in the instant application now before the Examiner. The diligence is excused because of the lack of the ability of the Applicant to obtain funds and because the Applicant could not personally fund the development. The Declaration by Application and the documents now before the Examiner clearly prove Applicant's diligence when the lack of funding is considered.

Next, the Examiner is requested to refer to Marconi Wireless Telegraph Co., of America v. United States, 57 USPQ 471 decided by the Supreme Court June 21, 1943. In Marconi the Supreme Court recognized diligence to obtain capital to promote the invention and the syndicate organized to finance laboratory experiments. This, Applicant submits, is no different than the attempts by Applicant to obtain financing from the United States Government through government contracts to finance Applicant's laboratory experiments which would have led to an actual reduction to practice.

However, actual reduction to practice was never achieved in this case. Instead, Applicant has a constructive reduction practice by virtue of the filing date of Applicant's application. Applicant submits that diligence has clearly been shown in the intervening period between the conception date and the actual filing date in the Patent Office as outlined in the previous paper. The case law is clear and teaches that efforts to obtain financing or lack of government funding are sufficient excuses for inactivity in a diligence period.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action in accordance thereof is requested. In the event there is any reason why the application cannot be allowed in this current condition, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems by Interview or Examiner's Amendment.

Respectfully submitted,



Ronald R. Snider  
Reg. No. 24,962

Date: May 8, 2003

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